

## REMARKS

This application pertains to a novel self adhesive sheet for the temporary protection of fresh paint surfaces of vehicles, such as cars.

Claims 1-3, 5-15 and 17-19 are pending.

The claims have been amended to limit the polyisobutylenes in the Markush Group of elastomers to polyisobutylenes having a number average molecular weight of from 120,000 to 425,000 g/mol. Support for this limitation is found in Table 1, page 11 of the specification, where Oppanol B 50 is shown to be a polyisobutylene (PIB) having a  $M_n$  of 120,000 g/mol and Oppanol B 150 is shown to be a polyisobutylene having a  $M_n$  of 425,000 g/mol.

Claims 1-3, 6-8, 12 and 10-13 stand rejected under 35 U.S.C 102(b) as anticipated by or, in the alternative under 35 USC 103(a), as obvious over, JP 7117195 translation.

Applicants have previously pointed out to the examiner that the JP reference teaches a pressure-sensitive adhesive containing a butyl rubber and liquid polyisobutylene as the main components (see the first full paragraph of page 4 of the reference). The JP reference leaves no room for any solid or even semi-solid form of the polyisobutylene, as at the top part of page 5 the reference teaches that the Flory

viscosity average molecular weight must be within the range of 30,000 to 100,000. Moreover, the reference teaches that if the molecular weight exceeds 100,000 the adhesive strength is poor.

This reference therefore teaches away from the use of polyisobutylene having a molecular weight over 100,000.

Applicants' claims, by contrast, require that their butyl rubber be blended with an elastomer. Applicants' claims recite, and their Examples demonstrate the use of a polyisobutylene having a molecular weight of 120,000 g/mol and 425,000 g/mol.

Applicants' claims therefore, to the extent they read on blends of butyl rubber and polyisobutylene, require polyisobutylenes which the JP reference teaches not to use.

In addition, Applicants' claims, to the extent they read on blends of butyl rubber and polyisobutylenes, require an elastomeric form of polyisobutylene. A liquid polyisobutylene, such as is recited by the JP reference, is clearly not an elastomer.

The Examiner contends that he believes that "...a liquid polyisobutylene is a low MW polyisobutylene elastomer, if not at all temperatures then certainly at least at a certain range of lower temperatures." Whether this belief is or is not correct is irrelevant to the issue of anticipation or obviousness in this case. The JP reference specifically requires a "liquid" and Applicants' require an elastomer. Whether or not the "liquid" of the JP reference could become an "elastomer" at certain conditions, the

JP reference does not teach using a liquid that is made into an elastomer...it teaches the use of a liquid. No person reading the JP reference could possibly be led to any blend of butyl rubber with any form of polyisobutylene other than the liquid form.

An elastomer is defined as something that is elastic, i.e., something that has the ability to be stretched and which retracts when released (see page 437 of Hawley's Condensed Chemical Dictionary, Thirteenth Edition, a copy of which is annexed hereto.) Clearly, a liquid is not an elastomer.

Therefore, no person reading the JP reference could ever be led to Applicants' novel self-adhesive protective sheet, and the rejection of claims 1-3, 6-8, 12 and 10-13 under 35 U.S.C 102(b) as anticipated by or, in the alternative under 35 USC 103(a), as obvious over, JP 7117195 translation should be withdrawn.

Claims 5, 9, 14, 15 and 18 stand rejected under 35 U.S.C. 103(a) as obvious over the JP '195 translation, and for claims 17 and 19 in view of EP '053.

The rejection, insofar as it applies to claims 5, 9, 14, 15 and 18 would seem to be a duplicate of the rejection discussed above, as the EP reference appears to be applied only to claims 17 and 19, which are not indicated as being rejected. In any case, to the extent that the omission of claims 17 and 19 was due to a clerical error, and that said claims are intended to be rejected by the Examiner over the cited combination of references, Applicants would respectfully point out that there is nothing in the EP reference that would overcome the differences pointed out above between Applicants'

claims and the disclosure of the JP reference. In addition, there is absolutely is no evidence that the isoprene content of the EP reference would meet the range claimed by Applicants (see Office Action of 12/19/05, page 3, paragraph numbered 6).

Accordingly, Applicants' claims cannot be seen as obvious over any combination of the JP '195 translation and EP '053, and the rejection of claims 5, 9, 14, 15 and 18 under 35 U.S.C. 103(a) as obvious over the JP '195 translation, and for claims 17 and 19 in view of EP '053 should now be withdrawn.

In view of the present remarks it is believed that claims 1-3, 5-15 and 17-19 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited.

#### CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account  
No. 14-1263.

Respectfully submitted,  
NORRIS, McLAUGHLIN & MARCUS, P.A.

By William C. Gerstenzang/  
William C. Gerstenzang  
Reg. No. 27,552

WCG/tmo  
Enclosure-Hawley's page 437 (2 sheets)  
875 Third Avenue- 18<sup>th</sup> Floor  
New York, New York 10022  
(212) 808-0700